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09/723,505	11/28/2000	Jules E. Gardner	P1133/20002	4909

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EXAMINER

BECKER, SHAWN M

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 06/18/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/723,505

Applicant(s)

GARDNER ET AL.

Examiner

Shawn M. Becker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 25 and 28-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 25 recites the limitation "The system of Claim 14" in line 1. There is insufficient antecedent basis for this limitation in the claim. Claim 25 is believed to depend from Claim 21 and not Claim 14.
4. Claim 28 recites the limitation "said indicator" in line 4 of page 35. There is insufficient antecedent basis for this limitation in the claim.
5. Claims 30 - 31 recite the limitation "the method of Claim 21" in line 1 of the claims. There is insufficient antecedent basis for this limitation in the claim. Claims 30 and 31 are believed to depend from Claim 28 and not Claim 21.
6. Claim 32 recites the limitation "the method of Claim 23" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 7-8, 11-15, and 19-20 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,370,537 to Gilbert et al. (hereinafter Gilbert).

Referring to claim 1, Gilbert discloses a method for delivering information to a person accessing a banner website from a terminal located remote from the source of the banner website, the terminal having an associated display upon which the content of the website is visually perceived by a person using the terminal and a cursor whose position is controllable by the person. See col. 17, lines 12-30, which describe how the banner is determined by an ad server, which is remote from the user's terminal. Fig. 26 shows a website, whose content is visually perceived by the user, with banner 2600. Col. 17, lines 44-47 describes how the user may move the mouse, which controls the position of a cursor.

The method of Gilbert provides initial signals from the source of the website or from another remote source when the website is accessed by the person to establish a banner area on the display (col. 17, lines 12-21), the banner area including banner information that is visually perceivable by the person when the website is accessed and plural sub-areas of the banner area. See Fig. 26, banner 2600, which shows three sub-areas (frames). Also, see col. 17, lines 40-44, which describe how the banner may be split into frames.

The method of Gilbert enables the person to control the cursor to position the cursor on any one of the sub-areas of the banner area to provide a selected sub-area, whereupon the person is automatically provided with respective additional visually perceivable information associated

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with the selected sub-area, the additional visually perceivable information being provided without requiring other action by the person, the respective additional visually perceivable information being imperceivable by the person until the cursor is located on the selected sub-area. See col. 17, lines 44-53, which describes how a mouse over an image in one of the frames causes a pop-up window (visually perceivable) to be displayed, which provide additional information associated with the selected sub-area (frame).

Referring to claims 7-8, the initial signals of Gilbert carry the instructions necessary for enabling the terminal to establish the additional visually perceivable information (pop-up) when in receipt of appropriate data, and the method of Gilbert re-accesses the source of the website or accesses another source for receiving the data upon which the instructions operate to provide the additional visually perceivable information. See col. 17, lines 25-31 and 50-54.

Referring to claims 11-12, the method of Gilbert receives the visually perceivable banner information, first identification data representative of the visually perceivable banner information, the additional visually perceivable information, and second identification data representative of additional visually perceivable information. See col. 17, lines 25-31 and 50-54, which describes how the banner information and additional information are served from an ad server, and therefore must be received by the terminal. The method of Gilbert specifies a placement of the additional visually perceivable information with respect to the visually perceivable banner information according to the first and second identification data. See Fig. 26, which shows the pop-up window (additional information) in relation to the banner.

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Referring to claim 13, the method of Gilbert must build a use map in accordance with the first and second identification data to associate the appropriate pop-up window with the appropriate image (sub-area) in the banner. See col. 17, lines 44-47. Also, see col. 12, lines 20-28.

Referring to claim 14, Gilbert discloses the step of providing additional visually perceivable information comprises the steps of:

- a) building a pop-up function in accordance with the additional visually perceivable information (col. 17, lines 44-47);
- b) adding HTML information to the pop-up function to provide an enhanced pop-up function (col. 17, lines 47-50 and col. 12, lines 26-28); and
- c) displaying the visually perceivable banner information and the additional perceivable information in accordance with the enhanced pop-up function. See col. 17, lines 40-50 and the pop-up associated with banner 2600 in Fig. 26.

Referring to claim 15, Gilbert discloses the step of altering associations between the sub-areas (frames) and the respective additional visually perceivable information and repeating step (b). See col. 17, lines 17-31 and 50-54, which describes how the content of the pop-up (additional visually perceivable information) and banner are determined by the ad server and may be changed by the advertiser.

Referring to claim 19, Gilbert discloses transmitting a request having request information to a server database (ad server) on a further website containing stored visually perceivable information in response to the positioning of the cursor on the selected sub-area (frame), selecting the additional visual information (pop-up window) from the stored visual information

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in response to the request information, and transmitting the selected stored visual information to the banner website. See col. 17, lines 44-54.

Referring to claim 20, the terminal of Gilbert provides a terminal display having a display iframe comprising the steps of displaying the visually perceivable banner information within the display iframe and displaying the additional visually perceivable information in response to positioning the cursor on the iframe. See col. 17, lines 12-47 and Fig. 26.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2, 6, 9-10, 21, and 25-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert.

Referring to claim 2, Gilbert shows a pop-up window associated with banner 2600 in Fig. 26, which substantially crosses the lower boundary of the banner area, but Gilbert does not explicitly show the pop-up window (visually perceivable information) is provided substantially outside the boundaries of the banner area. However, pop-up windows may be placed anywhere within a display and may comprise different sizes. As an example, see Fig. 18 of Gilbert, which shows a pop-up window (1802), substantially outside of the boundaries of banner area (1801). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the pop-up window of Gilbert substantially outside of the boundaries of the banner area, in order

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to prevent covering up the banner, and reducing its visibility or to enlarge the pop-up window to draw attention to it.

Referring to claim 21, Gilbert discloses a system for delivering information to a person accessing a banner website from a terminal located remote from the source of the banner website, the terminal having an associated display upon which the content of the website is visually perceived by a person using the terminal and a cursor whose position is controllable by the person. See col. 17, lines 12-30, which describe how the banner is determined by an ad server, which is remote from the user's terminal. Fig. 26 shows a website, whose content is visually perceived by the user, with banner 2600. Col. 17, lines 44-47 describes how the user may move the mouse, which controls the position of a cursor.

The system of Gilbert provides initial signals from the source of the website or from another remote source when the website is accessed by the person to establish a banner area on the display (col. 17, lines 12-21), the banner area including banner information that is visually perceivable by the person when the website is accessed and plural sub-areas of the banner area. See Fig. 26, banner 2600, which shows three sub-areas (frames). Also, see col. 17, lines 40-44, which describe how the banner may be split into frames.

The initial signals of Gilbert enable the person to control the cursor to position the cursor on any one of the sub-areas of the banner area to provide a selected sub-area, whereupon the person is automatically provided with respective additional visually perceivable information associated with the selected sub-area, the additional visually perceivable information being provided without requiring other action by the person, the respective additional visually

perceivable information being imperceivable by the person until the cursor is located on the selected sub-area. See col. 17, lines 44-53, which describes how a mouse over an image in one of the frames causes a pop-up window (visually perceivable) to be displayed, which provide additional information associated with the selected sub-area (frame).

Gilbert shows a pop-up window associated with banner 2600 in Fig. 26, which substantially crosses the lower boundary of the banner area, but Gilbert does not explicitly show the pop-up window (visually perceivable information) is provided substantially outside the boundaries of the banner area. However, pop-up windows may be placed anywhere within a display and may comprise different sizes. As an example, see Fig. 18 or Gilbert, which shows a pop-up window (1802), substantially outside of the boundaries of banner area (1801). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the pop-up window of Gilbert substantially outside of the boundaries of the banner area, in order to prevent covering up the banner, and reducing its visibility or to enlarge the pop-up window to draw attention to it.

Referring to claim 28, Gilbert discloses a method of enabling a user on a website to traverse a banner presented on the website to display an image (pop-up) in response to the traversing of the banner. The method of Gilbert provides the banner with a selected hot spot having an associated image (col. 17, lines 45-47), activates the hot spot when an indicator (mouse) traverses the selected hot spot and enables the associated image (pop-up) when the traversed hot spot is activated to provide an enabled image (see col. 17, lines 44-47 on how a pop-up is displayed in response to a mouse over). See the pop-up window over (adjacent) the

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banner 2600 in Fig. 26. The pop-up window does not have a button in the window for closing the window ('x'), and therefore is believed to remain enabled as long as the indicator (mouse) is disposed on the pop-up (enabled image), and the pop-up is removed when the mouse is moved off of it. It is typical for a mouse over event to last as long as the mouse (cursor) remains positioned over the image associated with the mouse over. The Examiner takes Official Notice of this teaching. It would have been obvious to one of ordinary skill in the art to ensure the pop-up window of Gilbert remains open as long as the cursor remains over the enabled image (pop-up), because the lack of movement of the cursor indicates the user is still reading the additional information.

Referring to claims 6, 9, and 25 the pop-up window of Gilbert (additional visually perceivable information) is displayed in a region (window) adjacent to the selected sub-area (frame). See the pop-up window over (adjacent) the banner 2600 in Fig. 26. The pop-up window does not have a button in the window for closing the window ('x'), and therefore is believed to remain perceivable to the person as long as the cursor remains on the selected sub-area (frame) or on the pop-up window. It is typical for a mouse over event to last as long as the mouse (cursor) remains positioned over the image associated with the mouse over. The Examiner takes Official Notice of this teaching. It would have been obvious to one of ordinary skill in the art to ensure the pop-up window of Gilbert remains open as long as the cursor remains on the selected sub-area (frame) or the pop-up window (region), because the lack of movement of the cursor indicates the user is still reading the additional information.

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Referring to claim 10, the additional visually perceivable information of Gilbert contains link information for linking the person to a further website when the person clicks on the selected region. See col. 17, lines 48-64.

Referring to claims 26-27, the initial signals of Gilbert carry the instructions necessary for enabling the terminal to establish the additional visually perceivable information (pop-up) when in receipt of signals transmitted from a further website in response to the instructions, and the initial signals of Gilbert require re-accessing the further website for selecting the transmitted signals. See col. 17, lines 25-31 and 50-54.

Referring to claim 29, in the method of Gilbert, a further website is associated with the associated image (pop-up) and further comprises the step of clicking on the enabled image and transporting the user to the further website in response to the clicking. See col. 17, lines 48-64.

Referring to claim 30, the banner in Gilbert is provided with a further hot spot and comprises the step of traversing the hot spot by the indicator (mouse) within the banner and enabling a further associated image (pop-up) in response thereto. See col. 17, lines 40-47, which describe how the banner may be divided into frames, each having an associated pop-up on a mouse over.

Referring to claim 31, the indicator of Gilbert is directed by a mouse and the user traverses the hot spot without clicking on the right or left button of the mouse. See col. 17, lines 44-47, which describe how a mouse over causes the pop-up to be displayed (activates the hot spot).

Referring to claim 32, Gilbert discloses the step of altering associations between the hot spots (frames) and the associated images and enabling the further associated image when the

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selected hot spot is traversed. See col. 17, lines 17-31 and 50-54, which describes how the content of the pop-up (additional visually perceivable information) and banner are determined by the ad server and may be changed by the advertiser.

11. Claims 3-5 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert and U.S. Patent No. 6,496,857 to Dustin et al. (hereinafter Dustin).

Referring to claims 3-5 and 22-24, Gilbert discloses additional perceivable information in the form of a pop-up window, but does not explicitly describe that the pop-up window contains audio information, video information, or mixed media information. However, Dustin describes a method for enhancing advertisements, which provides ads that contain audio, video, and/or mixed media information. See col. 3, lines 5-8. It would have been obvious to one of ordinary skill in the art at the time of the invention to enhance the pop-up window advertisements of Gilbert, such that they include audio, video, and/or mixed media information for a more affective form of advertisement as supported by Dustin.

12. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert and U.S. Patent No. 6,401,075 to Mason et al. (hereinafter Mason).

Referring to claims 16-18, Gilbert discloses that the advertisements may be customized according to a user profile or at the discretion of the advertiser (col. 17, lines 21-31), but Gilbert does not explicitly altering the associations between the sub-areas and the additional visually perceivable information in accordance with recorded performance parameters. However, Mason discloses methods of monitoring internet advertising, in which parameters (which are

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predetermined) representative of the advertisements (i.e. click-through) are recorded to provide recorded performance parameters, and the advertisements presented are altered in accordance with the recorded performance parameters. See col. 2, lines 39-51. Altering the advertisements in accordance with the recorded performance parameters is repeated to provide the advertiser with accurate results of the success of the advertisements. It would have been obvious to one of ordinary skill in the art to modify the associations between the frames of the banner (sub-areas) and the pop-up window (additional visually perceivable information) of Gilbert in accordance with recorded performance parameters as taught by Mason in order to provide the advertiser with information on the success of the advertisements in the pop-up window and alter the pop-up window and banner accordingly as supported by Mason.

Conclusion

13. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach methods of advertising through banners, methods of providing mouse over events, methods of positioning a cursor.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawn M. Becker whose telephone number is 703-305-7756. The examiner can normally be reached on M-T 8:00 - 5:30 and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Cabeca can be reached on 703-305-3116. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

smb

June 12, 2003



JOHN CABECA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER